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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,733	02/09/2004	Nobumasa Sasa	KOY-18	9205

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LUCAS & MERCANTI, LLP
475 PARK AVENUE SOUTH
15TH FLOOR
NEW YORK, NY 10016

EXAMINER

SELLERS, ROBERT E

ART UNIT PAPER NUMBER

1712

DATE MAILED: 10/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/774,733

Applicant(s)

SASA, NOBUMASA

Examiner

Robert Sellers

Art Unit

1712

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 12 October 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1, 4, 6 and 9-12.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☒ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See the attachment.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

Robert Sellers
Primary Examiner
Art Unit: 1712

1. The evidence presented in the declaration filed October 12, 2006 is unpersuasive. The safety, stability, film strength, solvent resistance and durability tests reported in the table on page 7 as well as Table 4 on page 77 of the specification is based on the evaluations of an observer to distinguish between the following subjective criteria as described on pages 73-76.

Epoxy Compound and Composition Safety: Nearly no change in skin irritation, rubefaction (undefined) and bulla (undefined).

The determination of the difference between a slight change within the realm of “nearly” no change, rebefaction? and bulla? could vary from observer to observer.

Stability: No precipitation and viscosity change, increased viscosity and precipitation.

Curability: It is unclear what is being measured for the curability values.

How is the viscosity change ascertained?

Film strength: No peeling, slightly peeled and easily peeled.

The difference between such qualifiers as “slightly” and “easily” could vary based on the particular observer.

Solvent resistance: No change, slight break and shrinkage, evident break and shrinkage.

At what minimum level of break and shrinkage is the “slight” criteria met? What is the distinguishing feature between “slight” and “evident” break and shrinkage?

The criteria for the durability test is not disclosed in the declaration or the specification.

The ratings for the tested properties are a function of the opinion of an observer and cannot be scientifically verified in the absence of empirical evidence such as microphotographs.

2. The use of different curing methods of 1 for Composition No. 1 of Table 4, 3 for the comparative composition involving the 3,4-epoxycyclohexylmethyl-3,4-epoxycyclohexane carboxylate (Epoxy 1, the closest prior art species from European Patent No. 118,748; page 15, Epoxy 1 and Takai Publication No. 2004/0242839, page 16, paragraph [0233]) and 4 for the comparative composition containing bis(3,4-epoxycyclohexylmethyl)adipate (Epoxy 2 of the European patent) could materially affect the results since it introduces another variable besides the type of cycloaliphatic polyepoxide.

3. The evidence is not commensurate in scope with the claims with respect to the myriad species of cycloaliphatic polyepoxides within the scope of claimed formula (2) and (3) including species with as many as four cycloaliphatic epoxy groups (r_1 and r_2 includes as many as 3), the diverse types of linking L_1 and L_2 moieties, as well as a species of formula (3) wherein the carbonyl groups quantified by p_2 and q_2 are not present (i.e. p_2 and q_2 represent 0). The formulae embrace significantly structurally diverse cycloaliphatic polyepoxides as exhibited in the specification on pages 11-13, Example Compounds 1 to 28, and pages 19-25, EP-1 to EP-51.

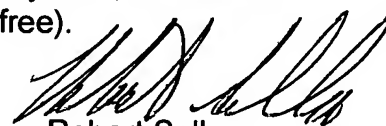
Art Unit: 1712

4. The showings of Table 3 cannot be directly compared to those of the declaration table because the types and amounts of the other components besides the tested cycloaliphatic polyepoxides have not been held constant to isolate the effect of the cycloaliphatic polyepoxide.

5. Independent claim 1 merely defines the presence of the cycloaliphatic polyepoxide of formula (1) or (2). The examples of the declaration and Table 3 of the specification further contains unclaimed components such as the oxetane compound OXT221 and triethyleneglycol divinyl ether designated as DVE-3. There is no evidence of record establishing the criticality of the claimed cycloaliphatic polyepoxide of formula (2) and (3) alone over the closest prior art 3,4-epoxycyclohexylmethyl-3,4-epoxycyclohexane carboxylate throughout a representative sampling of the broad number of species covered by formula (2) and (3).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Sellers whose telephone number is (571) 272-1093. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).



Robert Sellers
Primary Examiner
Art Unit 1712